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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,096	03/12/2004	Richard M. Hogan	4022-000014	8094
27572	7590	12/02/2005		
HARNES, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			EXAMINER DESAI, ANISH P	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 12/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/800,096

Applicant(s)

HOGAN ET AL.

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 31-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/12/04&amp;08/09/05</u>   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12 and 39-46, drawn to a process of glazing, classified in class 156, subclass 106.
  - II. Claims 13-30, drawn to a co-extruded composite, classified in class 428, subclass 41.8.
  - III. Claims 31-38, drawn to a method of preparing a multilayer plastic film, classified in class 264, subclass 173.16.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions (II,III) and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as in bonding variety of materials besides glass and plastic (i.e. metal, wood).
3. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process

(MPEP § 806.05(f)). In the instant case, the composite sheet could be made by another and materially different process such as a heat lamination.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Frentrup on 6/15/05 a provisional election was made with traverse to prosecute the invention of Group II, claims 13-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 and 31-46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 21 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 21 and 30 recite the limitation "thermoplastic

polyurethane layer". There is insufficient antecedent basis for this limitation in these claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 13,14,16-18,20,22,23, and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Katsuki et al. (US 4,427,743).

Katsuki et al. teach a laminated panel for use as safety glasses for vehicle (Column 4, lines 61-62) having good transparency (Column 2, lines 38-39). The laminated panel is comprised of a plastic sheet and a glass sheet (abstract). Figure 2 of Katsuki et al. shows, a laminated panel comprising a cushioning layer 4 sandwiched between the two plastic sheets 3A' and 3B' (Column 5, lines 26-30). According to Katsuki et al., fabrics made from polypropylene fibers can be embedded in the plastic sheets (Column 9, lines 9-11 and Column 9, lines 25 and 27). The plastic sheet of Katsuki et al. reads on the claimed expendable polymeric layer A. Moreover, the cushioning layer 4 of Katsuki et al. is made of a polyurethane resin (Column 7, line 61) and has sufficient tackiness or adhesiveness (Column 7, lines 44-47). Thus, the polyurethane cushioning layer of Katsuki et al. reads on the claimed thermoplastic adhesive layer B made of polyurethane as claimed in claims 13,22, 17, and 26. Regarding claims 18 and 27, at column 6, line 42, Katsuki et al. teach two cushioning

layers (Column 6, line 42). With respect to claims 20 and 29, at column 12, line 65, Katsuki et al. teach a polyurethane layer with thickness of 2 mm, which equates to 0.079 in (using 1 mm = 0.039 in). Accordingly, Katsuki anticipates the claimed subject matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 15,19,24, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuki et al. (US 4,427,743) as applied to claims 13 and 22 above in view of Friedman et al. (US 6,159,608).

The invention of Katsuki et al. is previously disclosed. According to Katsuki et al., there is no limitation on the material of the plastic sheet and transparent resins with moderate flexibility and strength that can be used as plastic sheets (Column 5, lines 3-7). Katsuki et al. are silent as to teaching the polymeric layer made of polyethylene and the thickness of the polymeric layer from 0.003 in to 0.01 in. However, Friedman et al. teach high clarity optical and safety glass laminates (abstract) used in the automotive industry (Column 1, lines 10-13). Additionally, Friedman et al. teach polyethylene based films having high clarity, very high moisture resistance, high UV light stability, and good heat resistance (Column 3, lines 18-22) used as an interlayer film in forming laminated glass product. Regarding claims 19 and 28, the thickness of the polyethylene film is

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0.125 mm to 1.0 mm. The thickness of the polyethylene film equates to 0.0049 in to 0.039 in respectively (using 1 mm = 0.039 in). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polyethylene film of Friedman et al. with a given thickness as a plastic sheet of Katsuki et al., motivated by the desire to provide a laminated panel with high clarity.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 21 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Katsuki et al. (US 4,427,743).

Although Katsuki et al. do not explicitly teach the claimed property of the expendable polymeric layer having a tensile strength greater than the mechanical bond between the thermoplastic polyurethane layer and the expendable polymeric layer, it is reasonable to presume that said property is necessarily present in the laminated panel of Katsuki et al. because like material has a like property. The applicant is using an expendable polymeric layer and a thermoplastic polyurethane adhesive layer to form a

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composite sheet and Katsuki et al. also disclose a laminated panel comprising a plastic sheet and a cushioning layer made of a polyurethane layer wherein the polyurethane layer has sufficient adhesiveness. The laminated panel of Katsuki et al. is similar in structure to the composite sheet of the present invention. The burden is upon the applicant to prove it otherwise. *In re Fitzgerald* 205 USPQ 594. In addition the presently claimed property would obviously have been present once the invention of Katsuki et al. is provided. Note *In re Best*, 195, USPQ at 433, footnote 4 (CCPA 1977) as to providing of this rejection made above under 35 U.S.C. 102. Accordingly, Katsuki et al. anticipates or strongly suggests the claimed subject matter.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD

*Haio Vo*

**HAIO  
PRIMARY EXAMINER**